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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			YOUNG, MICAH PAUL	
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TIMOTHY JOHN HENKEL

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Appeal 2008-5916  
Application 10/666,440  
Technology Center 1600

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Decided: December 18, 2008

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Before ERIC GRIMES, RICHARD M. LEBOVITZ, and STEPHEN WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to methods of treating recurrences of acute exacerbations of chronic bronchitis. The Examiner rejected some claims as anticipated, and the remainder of the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

#### STATEMENT OF THE CASE

The invention involves administering gemifloxacin to treat patients suffering from recurrences of acute exacerbations of chronic bronchitis.

Representative Claim 1 reads:

1. A method of reducing the recurrences of acute exacerbations of chronic bronchitis (AECB) in a patient in need thereof comprising administering a therapeutically effective amount of gemifloxacin, or a pharmaceutically acceptable salt thereof.

Claims 1-42 are on appeal.

The claims were rejected as follows:

- Claims 1, 4-8, 11-26, 34 and 35 were rejected under 35 U.S.C. § 102(a) as anticipated by File.<sup>1</sup>
- Claims 2, 3, 9, 10, 27-33 and 36-42 were rejected under 35 U.S.C. § 103(a) over the combined disclosures of File and Kim et al.<sup>2</sup>

#### THE ISSUE: FILE ET AL.'S PUBLICATION DATE

The Examiner rejected all the claims based on the File article alone or in combination with another reference. According to the Examiner, File is prior art because the August 2000 issue of the Journal of Chemotherapy ("the Journal") containing the File article would have been available to the public before Appellant's Sept. 15, 2000 priority date. (Ans. 6)

Appellant's sole contention is that the File article is not available as prior art under any subsection of 35 U.S.C. § 102. (App. Br. 9) According

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<sup>1</sup> T. File et al., *Gemifloxacin versus Amoxicillin/Clavulanate in the Treatment of Acute Exacerbations of Chronic Bronchitis*, 12 JOURNAL OF CHEMOTHERAPY 314-25 (August 2000).

<sup>2</sup> Kim et al., WO 98/42705 (October 1998).

to Appellant, there is no evidence that the File reference was received by a member of the public before Sept. 15, 2000, and “[a] journal article is not available as prior art until it is received by a member of the public.” (App. Br. 10).

The issue is whether the Examiner established the File article was accessible to the public before Sept. 15, 2000.

#### FINDINGS OF FACT

1. The File article was published in the August 2000 issue of the Journal of Chemotherapy. (Evid. App.)
2. Ms. Kristine Hensle, Reference Librarian at the USPTO, emailed the Journal and asked for “the publication date (print and online, if the latter is applicable) and the mail date (date the issue was mailed from the printer to the subscribers)” of the File article. (Evid. App.)
3. The Managing Editor for the Journal, Ms. Mary C. Forrest, confirmed the File article was in the August 2000 issue and further responded “[i]t is in our archives on our website and the print edition was mailed to subscribers around September 1, 2000.” (Evid. App.)
4. Appellant provided a copy of pages from the August 2000 issue of the Journal showing one of the pages stamped “LIBRARY NOV 03 2000 National Institutes of Health.” (Evid. App.)

#### PRINCIPLES OF LAW

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.  
35 U.S.C. § 102(a) (emphasis added).

“The statutory phrase ‘printed publication’ has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was ‘published.’ . . . Evidence of routine business practice can be sufficient to prove that a reference was made accessible before a critical date. . . . If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.”

*Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988) (citations omitted).

#### ANALYSIS

The Examiner argues that if the August 2000 issue of the Journal was mailed to subscribers on Sept. 1, 2000, a Friday, it would have been available to subscribers via postal service no later than Sept. 4 or 5, 2000. (Ans. 6). The undisputed evidence is that the Journal was mailed about Sept. 1, 2000. We agree that the Examiner made a sufficient showing of routine business practice that the article was accessible to a subscriber before Sept. 15, 2000.<sup>3</sup>

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<sup>3</sup> We give no weight to the Examiner’s arguments about electronic access because the Journal’s Managing Editor made no specific statement about electronic access in the critical time period before Sept. 15, 2000. The Journal’s website, provided in the Managing Editor’s signature block, touts “Online publication ahead of print” and “Online version of the Journal published weeks before the print version.” ([www.jchemother.it](http://www.jchemother.it), last visited Dec. 11, 2008). The Managing Editor did not answer the USPTO Librarian’s question about online access in the critical time period. There is

Appellant points to the Manual of Patent Examining Procedure (MPEP) at § 2128.02 as setting out a rule that a journal article becomes available as prior art on the date it is received by at least one member of the public.<sup>4</sup> The evidence in this case is that subscribers had access to the File article before the critical date. Proof of reception by a particular subscriber is not required. “If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.” *Constant*, 848 F.2d at 1568.

Appellant’s rebuttal evidence is a date stamp alleged to show that the library at the NIH did not receive the August 2000 issue of the Journal until Nov. 3, 2000. (App. Br. 9) Assuming that the NIH library uses the stamp to record the receipt date, this is not evidence that other subscribers did not receive the August 2000 issue before Sept. 15. (Ans. 6) Moreover, § 102(a) refers to “publication in this or a foreign country.” After the August 2000 issue of the Journal was mailed around Sept. 1, 2000, whether in Florence, Italy, where the Journal office is now located, or in another country, some subscribers likely had access to it before Sept. 15, 2000.

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no evidence that the online publication and access features described on the current website were available in September 2000.

<sup>4</sup> The MPEP cites *In re Schlitter*, 234 F.2d 882 (CCPA 1956), in which the issue involved the “known or used by others in this country” provision of § 102(a), not the “printed publication” provision. The C.C.P.A. later described the public availability portion of the *Schlitter* opinion as “clearly dictum,” but nevertheless agreed that “[t]he knowledge contemplated by section 102(a) must be accessible to the public.” *In re Borst*, 345 F.2d 851, 854 (CCPA 1965) (overruling *Schlitter*’s holding that knowledge of actual reduction to practice was required).

CONCLUSIONS OF LAW

We conclude that the Examiner established that the File article was accessible to the public before Sept. 15, 2000.

SUMMARY

We affirm the rejection of Claims 1, 4-8, 11-26, 34 and 35 under 35 U.S.C. § 102(a) as anticipated by File; and we affirm the rejection of Claims 2, 3, 9, 10, 27-33 and 36-42 under 35 U.S.C. § 103(a) over the combined disclosures of File and Kim et al.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

dm

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